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EXAMINER	
LETT, THOMAS J	
ART UNIT	PAPER NUMBER
2626	

DATE MAILED: 02/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/843,177	NISHIMURA, SHINICHI	
	Examiner	Art Unit	
	Thomas J. Lett	2626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *26 April 2001*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-22* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-10,and 12-22* is/are rejected.

7)☒ Claim(s) *11* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *26 April 2001* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *5*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

1. Claim 10 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The use/example of the global address communication is not clearly explained in the disclosure. It is not known whether the global address communication is used for multiple destinations or a single destination. The specification indicates that delivery will be directed to a single destination and it is unclear as to why a global address communication would be needed to address a single destination.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-4, 14,15, and 17-22 are rejected under 35 U.S.C. 102(e) as being anticipated by Bramnick et al (US Patent 6,058,169).

With respect to claim 1, Bramnick et al disclose a facsimile device (fax handling service 5) that transmits image information to a destination, comprising:

an electronic-mail control unit (fax handling service 5) used for transmitting the image information in an electronic-mail format (the recorded fax image can be delivered in digital form, e.g., e-mail *col. 4. lines 43-47*) to said destination through a computer network;

a real-time network control unit (fax handling service 5) used for transmitting the image information to said destination while said facsimile device and said destination are connected on line (the connections can be made in real-time, while a receiving computer is online *col. 2, lines 51-53*) through the computer network;

a destination table (a user/profile (database) col. 7, line 1), to which a destination address (e.g., a telephone number col. 7, lines 2-3) and a transmission method (examples are given col. 7, lines 3-26) are registered respectively for each destination and each destination address, said destination address being used for transmitting the image information through the computer network, said transmission method indicating one of said electronic-mail control unit and said real-time network control unit, wherein said facsimile device transmits the image information to said destination address by use of either said electronic-mail control unit or said real-time network control unit indicated by said transmission method if said destination address is specified as the destination

(the connections can be made in real-time, while a receiving computer is online *col. 2, lines 51-53*).

With respect to claim 2, Bramnick et al disclose a facsimile control unit (fax handling service 5) used for transmitting the image information to the destination through a telephone line network by following a fixed facsimile transmission procedure, wherein said facsimile device registers a destination number or the destination address, for said each destination, and the transmission method for said each destination address, in said destination table (selects transmission based on a pre-established database of numbers *col. 7, lines 1-3*), said destination number being used for transmitting the image information through the telephone line network.

With respect to claim 3, Bramnick et al disclose a transmission specifying unit specifying either said electronic-mail control unit or said real-time network control unit, wherein said facsimile device sets the transmission method corresponding to said destination address, to said transmission specifying unit, switches said transmission method by using said transmission specifying unit if necessary, and transmits the image information to said destination address by use of either said electronic-mail control unit or said real-time network control unit specified by said transmission specifying unit. (operations providing functions (real-time connections or email connections) associated with the present service (fax handling service 5) can be implemented by existing and/or yet to be developed switch management systems, col. 3, lines 7-10)

With respect to claim 4, Bramnick et al disclose a destination table includes a first table (a user/profile (database) col. 7, line 1), to which the transmission method is

registered for said each destination, and a second table (a user/profile (database) col. 7, line 1), to which the transmission method is registered for each predetermined condition, and said facsimile device transmits the image information to said destination address by using said transmission method registered in said second table as a first priority if a predetermined condition is detected (selection routing can be based e.g. upon: 1) a user/profile (database) pre-established for users of equipment 1; 2) the telephone number representing the direct dialed destination 4; or 3) a combination of factors including a user profile and the destination telephone number, col. 6, lines 67 – col. 7, line 5).

With respect to claim 14, Bramnick et al disclose that a facsimile device transmits the image information to said destination address by use of either said electronic-mail control unit or said real-time network control unit corresponding to said destination address, if said destination address is specified as the destination, and said transmission method is not registered (not specified in profile, Fig. 7, item 92) in said destination table (determination 90 is required to define the basis for route selection as either the calling site's profile or local telco defaults. If the basis is the calling site's profile, operation 91 is performed to select a route appropriate to that profile, and otherwise operation 92 is performed to select a route based on local telco defaults, col. 11, lines 35-40).

With respect to claim 15, Bramnick et al disclose that a facsimile device transmits the image information to said destination address by use of said real-time network control unit if said destination address is a local address (If a route is not explicitly

defined by the caller's profile (negative decision at 81), a route is selected in accordance with default rules locally applicable to this type of service (e.g. rules requiring forwarding to local destinations only through local analog switches and lines of the PSTN), col. 10, lines 54-59).

With respect to claim 17, Bramnick et al disclose a facsimile control unit (fax handling service 5) used for transmitting the image information to said destination through a telephone line network by following a fixed facsimile transmission procedure;

an electronic-mail control unit (fax handling service 5) used for transmitting the image information in an electronic-mail format to said destination through a computer network;

a real-time network control unit (fax handling service 5) used for transmitting the image information to said destination while said facsimile device and said destination are connected on line through the computer network; and

a direct/memory transmission specifying unit (fax handling service 5) specifying a transmission method in accordance with a destination address of said destination, for each destination, said transmission method indicating one of direct transmission and memory transmission, wherein said direct/memory transmission specifying unit can further specify usage of said electronic-mail control unit or said real-time network control unit for each transmission method, and said facsimile device transmits the image information to said destination by use of either said electronic-mail control unit or said real-time network control unit corresponding to said transmission method if said

destination address is selected (local fax management service 5 can select between three possible forwarding routes, col. 7, lines 15-27).

With respect to claim 18, Bramnick et al disclose a facsimile control unit (fax handling service 5) used for transmitting the image information to said destination through a telephone line network by following a fixed facsimile transmission procedure;

an electronic-mail control unit (fax handling service 5) used for transmitting the image information in an electronic-mail format to said destination through a computer network;

a real-time network control unit (fax handling service 5) used for transmitting the image information to said destination while said facsimile device and said destination are connected on line through the computer network; and

a direct/memory transmission specifying unit specifying a transmission method in accordance with a destination address of said destination, for each destination, said transmission method indicating one of direct transmission and memory transmission, wherein said direct/memory transmission specifying unit can further specify usage of said electronic-mail control unit or said real-time network control unit for each transmission method, and said facsimile device transmits the image information to said destination by use of either said electronic-mail control unit or said real-time network control unit corresponding to said transmission method if said destination address is selected (local fax management service 5 can select between three possible forwarding routes, col. 7, lines 15-27).

With respect to claim 19, Bramnick et al disclose a facsimile apparatus (fax handling service 5) transmits the image information to said destination address, by use of said real-time network control unit if the transmission method specified by said direct/memory transmission specifying unit is the direct transmission, or said electronic-mail control unit if said transmission method is the memory transmission (fax handling service 5 stores signals representing both the dialed sequence corresponding to the destination telephone number and the facsimile information to be transferred to the destination, and to manage transfer of the facsimile information to the destination offline to the sending equipment, col. 6, lines 8-13).

With respect to claim 20, Bramnick et al disclose a method of selecting a transmission method for transmitting image information from a facsimile device to a destination, comprising the steps of:

specifying the transmission method, that is, one of an electronic-mail transmission method (the recorded fax image can be delivered in digital form, through the external data network, to a modem and computer at the destination; e.g. as e-mail, col. 2, lines 44-47) and a real-time transmission method (the connections can be made in real-time, col. 2, lines 52-53), for each destination address used for transmitting the image information through a computer network; and

transmitting the image information to a destination address through the computer network by use of the transmission method corresponding to said destination address if said destination address is specified as the destination (a feature of the invention is that

the route chosen for delivery to the final destination can be selected on the basis of service parameters agreed to by calling users of the service, col. 2, lines 58-61).

With respect to claim 21, Bramnick et al disclose a method of selecting a transmission method for transmitting image information from a facsimile device to a destination (the route chosen for delivery to the final destination can be selected on the basis of service parameters agreed to by calling users of the service, col. 2, lines 58-61), comprising the steps of:

registering a destination number used for transmitting the image information through a telephone line network or a destination address used for transmitting the image information through a computer network, for each destination in a destination table (pre-recorded database profile, col. 2, line 13-14) (subscriber profiles can allow for some fax transmissions of a subscriber to be sent over entirely internal PSTN routes and other fax transmissions of the same subscriber to be sent over external data networks, col. 2, lines 22-25);

registering a transmission method, that is, one of an electronic-mail transmission method and a real-time transmission method, for each destination address registered in said destination table (pre-recorded database profile, col. 2, line 13-14) (subscriber profiles can allow for some fax transmissions of a subscriber to be sent over entirely internal PSTN routes and other fax transmissions of the same subscriber to be sent over external data networks, col. 2, lines 22-25); and

transmitting the image information to the destination address by use of the

transmission method corresponding to said destination address, if said destination address is specified as the destination (subscriber profiles can allow for some fax transmissions of a subscriber to be sent over entirely internal PSTN routes and other fax transmissions of the same subscriber to be sent over external data networks, col. 2, lines 22-25).

With respect to claim 22, Bramnick et al disclose setting the transmission method corresponding the destination address (the route chosen for delivery to the final destination can be selected on the basis of service parameters agreed to by calling users of the service, col. 2, lines 58-61), if said destination address is specified as the destination;

switching the transmission method (if route is not based on subscriber profile, Fig. 7, item 91) if necessary; and transmitting the image information to said destination address by use of said transmission method (can switch transmission method based on telco defaults, Fig. 7, item 92).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claims 5, 12, 13, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bramnick et al (US Patent 6,058,169) in view of Kamanaka et al (US Patent 6,625,646 B1).

With respect to claim 5, Bramnick et al does not disclose a document-size detecting unit detecting a document size of a document, wherein said facsimile device registers said document size as the predetermined condition, and determines the transmission method according to said document size. Kamanaka et al discloses a memory 15 stores a terminal performance control table 63 (FIG. 5), for storing data on the communications performance of each communications device, including paper size, (col 5, lines 19-22). Bramnick et al and Kamanaka et al are analogous art because they are from the similar problem solving area of storing conditions and parameters of a communications device. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to add the size determination feature of Kamanaka et al to the fax service feature of Bramnick et al in order to obtain a table capable of storing parameters to determine appropriate transmission. The motivation for doing so would be to store properties used in order to determine transmission.

With respect to claim 12, Bramnick et al does not disclose a document-size specifying unit specifying a document size of a document to be transmitted, wherein said destination table stores a first destination address used for transmitting the image information in the electronic-mail format through the computer network, and a second destination address used for transmitting the image information while said facsimile device and the destination are connected on line through the computer network, for said

each destination, and said facsimile device transmits the document to said destination by use of either said electronic-mail control unit or said real-time network control unit corresponding to the document size of said document specified by said document-size specifying unit to be outputted at said destination. Kamanaka et al discloses a memory 15 stores a terminal performance control table 63 (FIG. 5), for storing data on the communications performance of each communications device, including paper size, (col 5, lines 19-22). Bramnick et al and Kamanaka et al are analogous art because they are from the similar problem solving area of storing conditions and parameters of a communications device. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to add the size determination feature of Kamanaka et al to the fax service feature of Bramnick et al in order to obtain a table capable of storing parameters to determine appropriate transmission. The motivation for doing so would be to store properties used in order to determine transmission.

With respect to claim 13, Bramnick et al do not disclose that a facsimile device transmits the document to said destination by use of said electronic-mail control unit if the document size of said document is A4. Kamanaka et al discloses examples of transmission of a fax document using paper size A4. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to add the size determination feature of Kamanaka et al to the fax service feature of Bramnick et al in order to obtain a table capable of storing parameters to determine appropriate transmission. The motivation for doing so would be to store properties used in order to determine transmission.

With respect to claim 16, Bramnick et al do not disclose that a facsimile device calculates a data size of the image information read from a document, and transmits the image information to said destination by use of either said electronic-mail control unit or said real-time network control unit corresponding to said data size. Kamanaka et al discloses a memory 15 stores a terminal performance control table 63 (FIG. 5), for storing data on the communications performance of each communications device, including paper size, (col. 5, lines 19-22). At the time of the invention, it would have been obvious to a person of ordinary skill in the art to add the size determination feature of Kamanaka et al to the fax service feature of Bramnick et al in order to obtain a table capable of storing parameters to determine appropriate transmission. The motivation for doing so would be to store properties used in order to determine transmission.

4. Claims 6-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bramnick et al (US Patent 6,058,169) in view of well-known prior art.

With respect to claim 6, Bramnick et al does not disclose expressly that said facsimile device registers a value of said destination address as the predetermined condition, and determines the transmission method according to said value of the destination address. However, Bramnick et al discloses that subscriber profiles (containing parameters tailored for a user) can allow for some fax transmissions of a subscriber to be sent over entirely internal PSTN routes and other fax transmissions of the same subscriber to be sent over external data networks (col.2, lines 22-25). It would have been obvious at the time the invention was made to a person having ordinary skill

in the art to consider a subscriber profile registering an address as a predetermined condition and would determine method of transmission.

With respect to claim 7, Bramnick et al does not disclose that said facsimile device registers a data size of the image information as the predetermined condition, and determines the transmission method according to said data size. However, Bramnick et al discloses that subscriber profiles (containing parameters tailored for a user) can allow for some fax transmissions of a subscriber to be sent over entirely internal PSTN routes and other fax transmissions of the same subscriber to be sent over external data networks (col.2, lines 22-25). It would have been obvious at the time the invention was made to a person having ordinary skill in the art to consider a subscriber profile registering a data size as a predetermined condition and would determine method of transmission.

With respect to claim 8, Bramnick et al does not disclose a significance specifying unit specifying a degree of significance of a document, wherein said facsimile device registers the degree of significance of the document as the predetermined condition, and determines the transmission method according to said degree of significance if said degree of significance of the document is specified by said significance specifying unit. However, Bramnick et al disclose that subscriber profiles (containing parameters tailored for a user) can allow for some fax transmissions of a subscriber to be sent over entirely internal PSTN routes and other fax transmissions of the same subscriber to be sent over external data networks (col.2, lines 22-25). It would have been obvious at the time the invention was made to a person having

ordinary skill in the art to consider a subscriber profile specifying a degree of significance of a document as a predetermined condition and would determine method of transmission.

With respect to claim 9, Bramnick et al does not disclose said facsimile device registers a network condition of said computer network as the predetermined condition, and determines the transmission method according to said network condition. However, Bramnick et al disclose that the service provides ways of routing a document if faulty network conditions occur, col. 3, lines 16-21).

With respect to claim 10, Bramnick et al does not disclose that the facsimile device registers a global address communication as the predetermined condition, and determines the transmission method depending on whether said facsimile device performs the global address communication. However, Bramnick et al discloses that subscriber profiles (containing parameters tailored for a user) can allow for some fax transmissions of a subscriber to be sent over entirely internal PSTN routes and other fax transmissions of the same subscriber to be sent over external data networks (col.2, lines 22-25). It would have been obvious at the time the invention was made to a person having ordinary skill in the art to consider a subscriber profile registering an address as a predetermined condition and would determine method of transmission.

Allowable Subject Matter

5. Claim 11 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas J. Lett whose telephone number is 703-305-8733. The examiner can normally be reached on 7-3:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly Williams can be reached at 703-305-4863. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)305-3900.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, DC 20231

or Faxed to:

(703) 872-9314 (for Technology Center 2600 only).

Hand-delivered responses should be brought to:
Crystal Park II
2121 Crystal Drive
Arlington, VA Sixth Floor (Receptionist).

TJL (TJL)

KAWilliams

KIMBERLY WILLIAMS
SUPERVISORY PATENT EXAMINER